

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Appln. No.: 10/603,615  
Attorney Docket No.: Q76221

### **REMARKS**

Claims 1-20 are all the claims pending in the application. By this Amendment, Applicant editorially amends claims 1, 2, 5, and 6 for improved conformity with the U.S. practice and to cure minor informalities. The amendments to claims 1, 2, 5, and 6 were made for reasons of precision of language and consistency, and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. In addition, Applicant adds claims 7-20, which are clearly supported throughout the specification

#### **I. Preliminary Matters**

As preliminary matters, the Examiner has acknowledged Applicant's claim to foreign priority and has indicated receipt of the certified copy of the priority document. The Examiner has returned the initialed forms PTO/SB/08 submitted with the Information Disclosure Statements filed on June 26, 2003 and July 21, 2004. The Examiner has indicated acceptance of the drawings filed on June 26, 2003.

#### **II. Summary of the Office Action**

Claims 5 and 6 are rejected under 35 U.S.C. § 101 and claims 1-6 are rejected under 35 U.S.C. § 103.

#### **III. Claim Rejections under 35 U.S.C. § 101**

Claims 5 and 6 are rejected under 35 U.S.C. § 101. Applicant respectfully requests the Examiner to withdraw the rejection of claims 5 and 6 in view of the self-explanatory amendments being made herein.

IV. Claim Rejections under 35 U.S.C. § 103

Claims 1-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US 2001/0012051 to Hara et al. (hereinafter “Hara”) in view of U.S. Patent No. 5,953,050 to Kamata et al. (hereinafter “Kamata”). Applicant respectfully traverses these grounds of rejection in view of the following comments.

Independent claim 1, among a number of unique features, recites: “obtaining first image data by photography....combining other image data transmitted by other portable terminal apparatuses with the first image data to obtain synthesized image data.” That is, in an exemplary, non-limiting embodiment of the present invention, a photographing image is combined with other image data to obtain a synthesized image data.

The Examiner alleges that since Hara discloses displaying received data on a display device and at the same time having a small window for displaying images obtained by the device (¶ 84) and Kamata discloses combining various video streams obtained from different locations, the combined disclosure of Hara and Kamata meet the unique features of claim 1 (*see* page 4 of the Office Action). Applicant respectfully disagrees.

Hara only discloses displaying the received image and at the same time having a small window for the captured images. That is, in Hara, there is no disclosure or suggestion that these two images are combined or synthesized. Instead, in Hara, they are strictly kept separate. Furthermore, one of ordinary skill in the art would not have been motivated to combine these two images.

Kamata fails to cure the deficient disclosure of Hara. Kamata relates to video conferencing and not photography. Kamata addresses a completely different problem *i.e.*,

Kamata relates to providing flexibility in choosing which participants to watch in the video conference, whereas Hara relates to providing image processing that corresponds to the destination display device for purposes of device cost reduction and operating efficiency. In short, Kamata and Hara disclose systems that are mutually exclusive in their purpose.

Furthermore, Kamata only discloses combining images received from various different locations (Figs. 2 and 4). In Kamata, there is no disclosure or suggestion that the images being combined are the one that is received and another one that is obtained in the combining device. In addition, Kamata relates to video streaming and as such clearly fails to disclose or suggest combining an image obtained by photography.

Therefore, “obtaining first image data by photography....combining other image data transmitted by other portable terminal apparatuses with the first image data to obtain synthesized image data,” as set forth in claim 1 is not disclosed or suggested by the combined disclosure of Hara and Kamata, which lack combining an image obtained by photography with image received from another portable device.

In addition, the proposed modification changes the principle operation of Hara. That is, for the device of Hara to provide video conferencing as disclosed by Kamata would require serious modifications *e.g.*, a new program would have to be installed for video streaming. Because Hara seeks to reduce the cost of the device, it would be contrary to the purposes of Hara to include additional processors for streaming purposes from three or more sites. Alternatively, if only a single processor were to be maintained in Hara, it could not effectively handle streaming in a video conference due to the constant need to implement an interrupt from multiple

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sites (*see* Hara, ¶¶ 101 and 138). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), MPEP § 2143.01.VI. In short, one of ordinary skill in the art would not have and could not have combined Hara with Kamata.

For at least these exemplary reasons, claim 1 is patentable over Hara in view of Kamata. Accordingly, it is appropriate and necessary for the Examiner to withdraw this rejection. Claim 2 is patentable at least by virtue of its dependency on claim 1.

In addition, dependent claim 2 recites: “wherein the synthesized image data is obtained by cutting a portion of images representing the other image data and a portion of an image representing the first image data to match the size of a display displaying the synthesized image.” The Examiner acknowledges that Hara does not disclose or suggest these unique features of claim 2. The Examiner, however, contends that Kamata cures the deficient disclosure of Hara. Kamata, however, only discloses reducing the size of each video stream (col. 6, lines 3 to 13). That is, Kamata does not disclose or remotely suggest cutting a portion of the video stream. For at least these additional exemplary reasons, claim 2 is patentable over Hara in view of Kamata.

Next, independent claims 3 and 5 recite features similar to, although not necessarily coextensive with, the features argued above with respect to claim 1. Therefore, arguments presented with respect to claim 1 apply with equal force here. For at least substantially analogous exemplary reasons, therefore, independent claims 3 and 5 are patentable over Hara in

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view of Kamata. Claims 4 and 6 are patentable at least by virtue of their dependency on claims 3 and 5, respectively.

V. New Claims

In order to provide more varied protection, Applicant adds claims 7-20, which are patentable by virtue of their dependency and for additional features set forth therein.

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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